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09/329,668	06/10/1999	PETER J. WILK	W07-424	8390

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/329,668

Applicant(s)

WILK, PETER J.

Examiner

JAGDISH N PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,12,13,15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3-9,12,13,15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3624

#### DETAILED ACTION

1. This communication is in response to amendment filed 3/24/03.

#### *Response to Amendment*

2. Claim 8,9,15 and 17 have been amended and claims 10,11, 14 and 16 have been cancelled. Claims 1,3-9,12,13,15 and 17 are currently pending.

#### *Response to Arguments*

3. Applicant's argument that there is nothing in the RCT reference which indicates that technology disclosures are sent over the Internet to the host computer is not convincing. To begin with, the claims do not recite the Internet as a global communication network in any of the subject claims.

4. RCT is described as defining the state of the art in technology transfer (p. 1) where RCT web address is indicated as [www.rtech.com](http://www.rtech.com). Furthermore, the contact information is not just limited to telephone or ordinary mail. It has been customary, well before, the claimed invention for businesses and individuals to communicate via an electronic mail as has been implied in the RCT reference. Nowhere, in the reference the Internet as a preferred mode of communication is excluded as one of ordinary skill in the art would appreciate. It is therefore, clear and obvious to one of ordinary skill art that technologies

Art Unit: 3624

for commercial potential can be sent to the RCT host computer over a network (such as the Internet as disclosed in RCT).

5. Applicant merely recites the examiner's assertion of the secondary reference (Cyber-securities) as teaching the missing elements of transmitting identification of the advances together with respective values of the determined fixed monetary amounts as presented the prior office action. The IPO reporter is irrelevant to claim 1 discussion as it was not applied to rejection of claim 1. On this basis the examiner asserts that the applicant's response and arguments to claim 1 rejection are defective and not convincing. Accordingly, rejection of claims 1 and 3-7 are maintained as per prior office action.

6. Applicant has amended claim 8 so as to incorporate in it limitations of claims 10 and 11 (alternatively, 14 and 16). The only argument forwarded by the applicant in support of the amended claim 8 is that the primary reference, RCT fails to teach or suggest the transmission of technology over the Internet. This argument has been already addressed in detail in response of claim 1 arguments as discussed above.

#### ***Claim Objections***

7. Claim 8, recites "further comprising" without referring to any specific limitation which <sup>i</sup>is subject of the further

Art Unit: 3624

limitation. For examination purpose, claim is interpreted without "further comprising" line.

Claims 12-13 are objected to as being improperly dependent on claim 11 which has been canceled by the amendment. For examination purpose claim 12 has been analyzed as being dependent on claim 9.

Appropriate correction(s) is required.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over RCT's Tips for Investors (RCT) and further in view of "The Internet and the Cyber-securities Marketplace" (Cyber-securities).

Claim 1. RCT discloses a method for facilitating financing of new technology, comprising:

Art Unit: 3624

maintaining a host computer connected to a global computer network for receiving, over said network from remote computers, information describing purported advances in technology;

accessing said host computer to obtain said information;

(RCT p. 1 para 4 "appraise technologies sent to RCT for commercial potential..., note that RCT is internet based i.e. inherently includes a host computer and receives information over a network as recited);

performing an evaluation of said advances in technology to determine, for each of said advances, a fixed monetary amount to be contributed in exchange for a unit of equity in a prospective technology development venture to develop the respective one of said advances (p. 1 para 5 Venture Development and financing plans...financing plans for adding value to early stage development which also include offering equity share in the technology venture);

RCT fails to explicitly teach transmitting identifications of said advances together with respective values of the determined fixed monetary amounts as per claim 1.

Cyber-securities, in the same field of endeavor, however, teaches a method for facilitating financing of new technology (conducting "Roadshows" over the Internet), to preselected computers (only available to large investors, section 3. ), identifications of said advances (inherent to Roadshows because

Art Unit: 3624

it involves presentations made by the issuer to large investors) together with respective values of the determined fixed monetary amounts (part of the "prospectus") . Cyber-securities teaches both transmitting identification of advances with respective values of the determined fixed values (p.3 header 3 titled conducting "Roadshows" over the Internet) and operating said computer ...respective bids for desired number of units of equity in the technology development ventures as recited (an inherent process step of public offering of securities which is subject of the reference).

It would have been obvious to one of ordinary skill in the art at time of the invention to implement the transmitting of identification of the advances together with respective values of the determined fixed monetary amounts as disclosed by the Cyber-securities article into the RCT reference so as to develop a method for facilitating financing of new technology as per claim 1 because the resulting method would facilitate communication of the technology advances together with their respective values of fixed monetary amounts to a large potential and interested investors without regards to any geographic or time limitations and would contribute to a more open, efficient and democratic financing of the new technology for which the

Art Unit: 3624

financing is sought. (other benefits of such combined method are described throughout both references).

Claim 7. The method defined in claim 1 wherein the transmitting of said identifications and the respective values of the determined fixed monetary amounts is undertaken via said host computer (the RCT is implemented on a web host and determination of fixed monetary amounts is undertaken by RCT, para 5 p.1).

10. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over RCT and Cyber-securities references as applied to claim 1 above, and further in view of article "Revolution or Evolution? W.R. Hambrecht & Co. Brings underwriting to the Internet", The IPO Reporter, v 23, n 7, p4, Feb 1999 (hereafter the IPO Reporter).

Claims 3-5: the RCT or Cyber-securities references fail to explicitly recite, "setting a maximum number of units of equity", "automatically tally totals of units" and "transmit a bidding termination signal" are routine and customary steps in IPO process.

The limitations recited in the subject claims refer to customary steps performed in trading and/or IPO offering by an entity such as a market maker or a managing firm of an IPO.



Art Unit: 3624

Thus, the recited claim limitations are within the scope of references cited above because these procedural steps are required and anticipated in conducting of an on-line financing of new ventures or IPOs as discussed in the IPO reporter reference as an example. In this regard official notice is taken that setting a maximum number of units of equity, automatically tally total of units, transmitting bidding termination signals (as per recitation in claim 3), automatically advise the preselected computers (i.e. bidders) (claim 4), automatically record identities of preselected each computers (claim 5) are old and well known and anticipated in the art of trading of financing instruments including IPOs and therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these steps in the method for facilitating financing of new technologies as discussed in claim 2 analysis because this implementations would lead to a financing of new technologies (ventures) which would conform to the existing market and regulatory requirements, which would facilitate required communication of bidding status to the bidder and ultimately lead to more open, efficient and democratic financing of the new technologies.

Art Unit: 3624

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over RCT and further in view of Cyber-securities as applied to claim 1 and further in view of McNabb (US Pat. 6,289,462).

As per analysis of claim 1, RCT and Cyber-securities references while teach all limitations of claim 1, do not teach that identifications and respective values are transmitted in encrypted form. McNabb, in the same field of endeavor, however, teaches a method of providing security as applied to communication of data pertaining to financial transactions (McNabb col. 2 L 36-47).

It would have been obvious to one of ordinary skill in the art at the time of invention to have the identification and the respective values transmitted in encrypted form because encryption of identification and the respective values would provide a measure of security from unauthorized access and thus would help maintain confidentiality of the transmitted data.

9. Claims 8-9, 12,13, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cyber-securities and further in view of RCT.

Per claim 8, Cyber-securities teaches a business method for enhancing investment in new technologies, comprising:

Art Unit: 3624

Selecting a predetermined number of potential investors (refer to section 3. Conducting "Roadshows", presentations are made to large investors ...etc., this is disclosed throughout the discussion of conducting of "Roadshows");

transmitting, to potential investors, investment opportunities each comprising an identification of purportedly new technology and a fixed monetary amount to be exchanged in return for a predetermined unit of equity in a prospective technology development venture to develop the respective technology (refer to section 3. Conducting "Roadshows" over the Internet, Note that "presentations" made by the issuer constitute investment opportunities, other elements of the limitations are fixed monetary amount to be exchanged for a predetermined unit of equity.. is discussed in the same section in the subsequent paragraphs);

Cyber-securities fails to expressly disclose limitations (iii) receiving bids..from at least some of the investors,..including operating a host computer to monitor messages.. (iv) recording identities of the bidding investors and the number of units of equity bid (v) automatically tallying total units bid and (vi) terminating bidding upon attainment of a predetermined number of units bids as recited in the subject claim. However, it is noted that these are customary steps

Art Unit: 3624

performed in trading and/or IPO offering by an entity such as a market maker or a managing firm of an IPO and therefore, these limitations are inherently disclosed in Cyber-securities. Thus, the claim limitations are within the scope of Cyber-securities because it concerns public offering of Securities. Furthermore, these procedural steps are required and anticipated in conducting of an on-line financing of new ventures as discussed in section 5. Direct Public Offerings (DPO's) (note that the steps (iii)-(vi) are required regardless of the selection of investors (preselected or not).

Official notice is taken that receiving bids for units of equity from investors over a global computer network, recording identities of the bidding investors and the number of units of equity bid; automatically tally units of bid, and terminating bidding upon attainment of a preselected number of units sold are old and well known and anticipated in the art of trading of financing instruments including IPOs and therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these steps in the method for facilitating financing of new technologies as discussed in claim 1 analysis because this implementations would lead to a financing of new technologies (ventures) which would conform to the existing market and regulatory requirements, which would

Art Unit: 3524

facilitate required communication of bidding status to the bidder and ultimately lead to more open, efficient and democratic financing of the new technologies.

Cyber-securities fails to disclose that the host computer is operated to monitor information describing purported advances in technology and selecting prospective technology development venture from among the purported advances in technologies.

However, RCT, in the same field of endeavor, teaches a business method for enhancing investment in new technologies wherein a host computer (RCT web site) monitors information arriving over said global computer network (the Internet), said information describing purported advances in technology, further comprising selecting said prospective technology development venture from among the purported advances in technology described in the information arriving over said global computer network (appraise technologies sent to RCT .... , p.1, and How does RCT Appraise Technologies? further teach appraisal of technologies sent to RCT by inventors. Since only some of the technologies meet the criteria for its commercialization...).

It would have been obvious to one of ordinary skill in the art at time of the invention to combine to combine monitoring of information describing purported advances in technologies and further selecting a prospective technology development venture

Art Unit: 3624

(appraisal of one of the technologies sent to RCT) as disclosed by RCT and transmitting of identification of the advances together with respective values of the determined fixed monetary amounts as disclosed by the Cyber-securities reference so as to develop a method for facilitating financing of new technology as per claim 8 because the resulting method would facilitate communication of the technology advances together with their respective values of fixed monetary amounts to a large potential and interested investors without regards to any geographic or time limitations and would contribute to a more open, efficient and democratic financing of the new technology for which the financing is sought. (other benefits of such combined method are described throughout the cited references).

Claim 9: respective identification and the respective fixed monetary amount over a global computer network (the Internet) are transmitted to potential investors using a host computer (Cyber-securities : Road shows include prospectus for the underwritten new technologies, and is presented over the Internet).

Claims 12. wherein the automatic tallying of the total units bid includes operating said host computer to add units bid by respective ones of said bidding investors (refer to analysis of claim 8).

Art Unit: 3624

Claim 13. transmitting of termination signal to the preselected computers (refer to Cyber-securities p. 5 " a qualified" investor).

Claim 15. analyzed as in claim 12.

Claim 17. analyzed as in claim 13.

### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

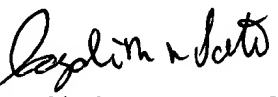
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

Art Unit: 3624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup> Floor, Alexandria VA 22202.

  
Jagdish N. Patel

(Examiner, AU 2164)

June 02, 2003